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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/687,281

10/16/2003

Naomi L. Nakao

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7590

10/19/2006

R. Neil Sudol
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EXAMINER

AHMED, AAMER S

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/687,281	Applicant(s) NAKAO, NAOMI L.	
	Examiner Aamer S. Ahmed	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19,21-24 and 39-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19,21-24 and 39-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 1-7, 10-19, 21-24 and 39-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates et al U.S. Patent Number 6,348,056 in view of Bates et al U.S. Patent Number 5,788,710 A.

Bates et al ('056) discloses, a medical instrument comprising a tubular member (12); an elongate member (40) disposed at least partially inside the tubular member (12); and a resilient loop (20) having a substantially planar fully expanded configuration of a first size (24) attached to one end of the elongate member (see figure 1), the loop (20) including a bend (see figure 1) on a side of the loop opposite the elongate member (40), the loop further including two loop sections (22, 24) each extending between the elongate member (40) and the bend, at least one of the loop sections being formed with at least one notch or dent or indentation or dimple (between 22 and 24) for enabling a use of the loop in at least one second size smaller than the first size upon a positioning of the loop by moving the elongate member and the tubular member relative to one another so that the notch or dent or indentation or dimple is disposed at a mouth

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opening of the tubular member (15); and one of the loop sections includes a second bend (at midsection of 24 as shown in figure 2) disposed between the first bend and the notch, the second bend defining a concavity facing towards the other of the loop sections (see figure 2); wherein each of the loop sections is formed with a respective notch or dent or indentation or dimple for enabling use of the loop in the second size upon a positioning of the loop relative to the tubular member so that the notches or dent or indentation or dimples are disposed at the mouth opening of the tubular member (see figure 1); wherein the notches or dent or indentation or dimples are disposed at substantially the same first distance from the one end of the elongate member and substantially the same second distance from the first bend (see figure 1). Furthermore, wherein the first distance is approximately 30% to approximately 40% of the sum of the first distance and the second distance, each of the notches or dent or indentation or dimples includes a pair of linear segments connected to one another by an arcuate bight, the segments being disposed at an angle of approximately 80° to approximately 120° relative to one another, the bend is part of a nose (see figure 1) projection of the loop, each of the loop sections including a respective second bend disposed between the nose projection and the respective one of the notches or dent or indentation or dimples, the respective second bends in the loop sections are located at approximately the same distance from the nose projection so that the loop is provided with an enlarged distal end portion (see figure 3) and comprising a pouch slidably (24) attached to the loop, the loop made of an electrically conductive material (col. 7 line 20). In addition Bates et al teaches, that the notch or dent or indentation or dimple of each one of the

loop sections extends toward the other loop section, the planar configuration loop lies in a single plane, the notches or dent or indentation or dimples being located in the plane (see figures 1 and 3), the loop has a relaxed configuration wherein the loop sections are spaced from one another by a loop width, each of the notches or dent or indentation or dimples having a width dimension measured in a direction from the respective loop section towards the other loop section, the width dimension being no larger than approximately fifteen percent of the loop width, the notches or dent or indentation or dimples each have a V shape (see figure 3). Moreover, the loop section is curved in a fully expanded configuration of the loop, the other of the loop sections being straight in the fully expanded configuration of the loop (see figure 3) and wherein the notch or dent or indentation or dimple is one of a plurality of notches or dent or indentation or dimples formed along the one of the loop sections, the notch or dent or indentation or dimple is located at a first distance from the one end of the elongate member and a second distance from the first bend, the first distance being approximately 30% to approximately 40% of the sum of the first distance and the second distance (see figure 3), the bend is a first bend, the one of the loop sections including a second bend disposed between the first bend and the notch or dent or indentation or dimple, the second bend defining a concavity facing towards the other of the loop sections; and wherein the loop in the planar configuration lies in a single plane, the notch or dent or indentation or dimple being located in the plane (see figure 3).

Furthermore, Bates et al discloses, a medical method comprising providing an instrument including a tubular member (12), an elongate member (40) disposed at least

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partially inside the tubular member (12), and a resilient loop (20) with a planar configuration of a first size attached to one end of the elongate member, the loop including a first bend on a side of the loop opposite the elongate member, the loop further including two loop sections (see figure 3) each extending between the elongate member and the bend, at least one of the loop sections being formed with at least one respective indent or indentation (see figure 3) extending inside the loop toward the other of the loop sections; the one of the loop sections includes a second bend (see figure 2) disposed between the first bend and the indentation, the second bend defining a concavity facing towards the other of the loop sections; inserting an endoscope into a patient, the endoscope having a biopsy channel; inserting the instrument through the biopsy channel, the loop being disposed in the tubular member during the inserting of the instrument; after the inserting of the endoscope and the inserting of the instrument, pushing the elongate member to eject the loop at least partially from the tubular member at a distal end of the endoscope, using the at least partially ejected loop to encircle a first desired tissue mass of a first size inside the patient, the loop being substantially entirely outside of the tubular member during the using of the loop; and using the at least partially ejected loop to encircle a second desired tissue mass of a second size inside the patient, the second size being substantially smaller than the first size, the indent or indentation being initially disposed at a mouth opening of the tubular member during the using of the loop to encircle the second desired tissue mass (col. 7 line 59).

Bates et al ('056) fails to explicitly disclose a dent in a loop section when fully expanded.

Bates ('710) discloses a similar device including a dent (pointed to as 18c in fig. 1), in a loop section when fully expanded.

It would have been obvious to one having ordinary skill in the art at the time of invention by the applicant to add the dent of the type taught by Bates ('710) in order to maximize the area in which to grasp a poly.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates et al U.S. Patent Number 6,348,056 in view of Bates et al U.S. Patent Number 5,788,710 A and further in view of Nakao U.S. Patent Number 5,782,840.

Bates et al ('056) in view of Bates et al ('710) disclose the device as described above, but fail to disclose a pouch made of netting material slidably attached to the loop.

Nakao discloses a similar device with a net pouch (20 fig. 7A).

It would have been obvious to one having ordinary skill in the art at the time of invention by the applicant to modify the device of Bates et al in view of Bates et al by adding the net pouch of the type taught by Nakao, in order to provide a cumulative polyp retrieval system.

Response to Arguments

Applicant's arguments with respect to claims 1-19, 21-24, 39-50 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aamer S. Ahmed whose telephone number is 571-272-5965. The examiner can normally be reached on Monday thru Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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